

REMARKS

This is a simultaneous amendment with request for continued examination (RCE) filed under 37 C.F.R. § 1.114.

I. WITHDRAWN CLAIMS

The withdrawn dependent claims 12 to 14 for a saw blade configuration (Group IV) have been canceled.

The independent claim 7 of Group III has been amended so that it is now a dependent claim, which depends on the main independent claim 27 for the elected group I claims, the claims for a handheld power saw with a specific bracing means. Thus like the Group II claims for the power saw with the specific coupling means, the Group III claims should be rejoined and allowed in the event that the linking claim, new independent claim 27, is allowed in accordance with M.P.E.P. § 821.04.

Applicants reserve the right to reintroduce any claims for the non-elected subject matter in subsequently filed continuing applications for further prosecution.

II. SUPPORTING DISCLOSURE FOR THE NEW AND AMENDED CLAIMS

New independent handheld power saw claim 27 is supported by the disclosures in applicants' originally filed specification and drawings.

That the handheld power saw has a housing is supported by page 7, line 11, of the applicants' specification and the housing 20a shown in applicants' figures.

That the handheld power saw has a lifting rod that is driven to oscillate linearly... by a drive mechanism connected with it (by the eccentric device) is supported by the disclosure between lines 5 and 8 on page 8 of the applicants' specification.

That the lifting rod and the drive mechanism are "in" the housing is supported by figs. 1, 2, and 8 (the term "in" must be interpreted broadly in examination so that it is not limited to mean inside or within).

That the saw blade extends in a longitudinal direction is supported by line 26 of page 7 of applicants' specification. That the

oscillating motion of the saw blade takes place in a direction corresponding to the longitudinal direction of the saw blade is supported by page 7, lines 24 to 26, of the applicants' originally filed specification.

The structural limitations of the saw blade with the T-shaped extension on the guide region (42a, fig. 5) of the saw blade, which is insertable in the housing (fig. 2), which were included in the fourth paragraph of the body of claim 27, i.e. lines 8 to 15 of claim 27, are supported by the paragraph between lines 16 and 26 on page 8 of the applicants' originally filed specification. The retaining region and T-shaped extension are introduced in claims 17 and 18 of page 8 and the end region is introduced in lines 24 to 26 of page 8.

Applicants' fig. 2 shows the longitudinally extending recess. The recess was not originally described in the applicants' specification, although it was shown in fig. 2 (Note that elements disclosed in a drawing figure but not in the specification may be included in an amended claim and are not considered new matter).

That the coupling means is located on a front end of the lifting rod is supported by lines 13 and 14 on page 8 of applicants' specification (the second part 58a is part of the lifting rod).

The coupling means limitations in the fifth paragraph of claim 27 are also disclosed in lines 16 to 26 on page 8 of applicants' originally filed specification.

The guide assembly limitations were present in the previously filed independent claims and the paragraph bridging pages 7 and 8 of applicants' specification. Particularly the bracing means are disclosed in that paragraph.

New independent claim 27 also includes the features and limitations of claim 19, which limits the guide assembly to two bracing means arranged on opposite sides of the saw blade when the saw blade is connected with the lifting rod.

The pressure roller and pressure bolt limitations in the last two paragraphs of claim 27 are generally supported by the paragraph bridging pages 7 and 8 of the specification, especially page 7, lines 23 to 25, of the applicants' specification. That the pressure roller bears on an edge of the saw blade on an opposite side of the saw blade from the side on which the cutting edge 30a is arranged (see the last line on page 10 of the applicants' specification) is supported by the disclosures in figs. 2 and 5.

That the pressure bolt is arranged to bear on an edge of the saw blade in the longitudinally extended recess is also supported by fig. 2.

The specification has been amended to include some of the features that were shown in the drawing and included in the new claim 27, but not included in the originally filed specification.

The new independent claim 30 is drafted with similar features as claim 27, but is of greater scope because some of the limiting wording in claim 27 has not been included in claim 30.

New dependent claims 28 and 31 include features and limitations from canceled claim 5.

New dependent claims 29 and 32 include the features and limitations of canceled claim 21, regarding the nature of the materials used for the bracing means.

III. CHANGES IN THE SPECIFICATION AND DRAWING

The first paragraph in the “Background of the Invention” section on page 1 of the specification was amended to delete the references to the claims by number to avoid confusion during prosecution and in the event that a patent issues. The references were replaced by subject matter from the original claims.

The wording of the first paragraphs in the “Summary of the Invention” section on page 1 of the specification was amended to particularly point out broadly disclosed inventive features versus features of the known power saws.

The paragraph bridging pages 7 and 8 was amended to provide a basis for new limitations in the new claim 27, especially the longitudinally extended recess 110a in the guide region of the saw blade 12a, which has also been illustrated in the drawing. In addition, further details of the engagement of the pressure bolt and pressure roller with the guide region 42a of the saw blade 12a have been included in this paragraph. Edges 112a and 114a and all features added to the specification are supported by disclosures in the drawing, especially fig. 2.

However all elements of a claimed apparatus must be illustrated in the drawing in accordance with 37 C.F.R. 1.84. Accordingly the longitudinally extended recess, the upper edge of the saw and the edge of the saw in the recess have been accorded drawing reference numbers 110a, 112a, and 114a respectively and replacement sheets for sheet 2/7 and 4/7 with amended figures 2 and 5 accompany this amendment.

Entry and approval of the changes in the amended figures 2 and 5 is respectfully requested.

IV. CHANGES IN THE ABSTRACT

The original abstract was not in a form that complies with U.S. Patent Office Rules, because it was in two paragraphs and made reference to fig. 2.

A new abstract has been prepared on a single sheet of paper and appears herein above. It is less than 150 words and does not use legalistic wording. Furthermore it is a summary of the subject matter of the new independent handheld power saw claim 27.

V. INDEFINITENESS REJECTION AND OBJECTION

Claims 2, 3, 5, 6, 19 to 20, and 22 to 25 were rejected as indefinite under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the invention.

Claims 2, 3, 5, 6, 19 to 20, and 22 to 25 have been canceled, obviating their rejection on the grounds of indefiniteness.

Also the objection to the wording in claims 18 and 23 on page 2 of the Office Action has been obviated, because of the cancellation of these claims and because the objected-to wording is no longer used in the claims.

However the basic question regarding the saw blade is still relevant to the claims.

The new independent claims and the amended claims have been drafted so that the saw blade is part of the claimed power sawing apparatus. However the independent claims 27 and 30 have been drafted with terms such as “connectable” and “insertable” because these claims have been drafted to cover the power saw

apparatus as it might be marketed in which the saw blade is not connected with the rest of the power saw apparatus, because the applicants contemplate providing several different saw blades of similar structure with the sawing apparatus (e.g. with different saw teeth configurations, such as for a rip saw and fine teeth), which is explained on page 7, lines 7 to 9, of the applicants' specification.

Accordingly it is respectfully submitted that the new claims 27 to 32 and amended claims 4 and 7 to 11 should not be rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the invention, for the reasons described on pages 3 and 4 of the final Office Action.

VI. ANTICIPATION REJECTION

Independent claim 24 and dependent claims 2, 3, 5, 6, 19, 20, 22 and 24 were rejected as anticipated under 35 U.S.C. § 102 (b) by Godfrey, et al, US 3,155,128.

The apparatus claimed in applicants' new independent claims 27 and 30 has a lifting rod, a saw blade, a coupling means and a guide assembly with at least one lateral bracing means, **but also** the pressure roller 52 and pressure bolt 50, which act to guide and

straighten the reciprocating or oscillatory motion of the saw blade in operation.

Godfrey does not disclose or suggest a pressure roller 52 on which the upper edge (or outer surface) of the saw blade would bear during its oscillatory motion.

Godfrey does not disclose or suggest a pressure bolt 68 that bears on an edge (or inner surface) of the saw blade in an elongated recess in the end of the saw blade that is inserted into the housing.

These latter features were included in independent claim 16, which was not rejected on the basis of the disclosures in Godfrey alone on any ground.

It is well established that each and every limitation of a claimed invention must be disclosed in a single prior art reference in order to be able to reject the claimed invention under 35 U.S.C. 102 (b) based on the disclosures in the single prior art reference. See M.P.E.P. 2131 and also the opinion in *In re Bond*, 15 U.S.P.Q. 2nd 1566 (Fed. Cir. 1990).

Godfrey does not disclose a saw apparatus with any pressure bolt or pressure roller, which guides the saw blade itself during its oscillatory motion. The saw blade is entirely outside of the housing of the saw apparatus in the case of Godfrey, so that there is no way to mount such rollers and bolts in Godfrey's apparatus.

For the aforesaid reasons and because of the new limitations in applicants' new independent claims, it is respectfully submitted that new claims 27 to 32 and amended claims 4 and 7 to 11 should not be rejected as anticipated under 35 U.S.C. § 102 (b) as anticipated by Godfrey, et al, US 3,155,128.

VII. OBVIOUSNESS REJECTION

Claims 2, 3, 5, 6, 16, and 18 to 25 were rejected as obvious under 35 U.S.C. § 103 (a) over Godfrey, et al, US 3,155,128, in view of Odendahl, et al, US 5,644,847.

A. Differences between the Claimed Invention and Prior Art

Odendahl, et al, does disclose an improved compass saw apparatus that has a guiding sword acting as a supporting element for the saw blade extending parallel to the saw blade, which can be

elastically supported and pivotable (claims 1 to 3; column 1, “summary”). In some embodiments a guiding roller is arranged at the end of the guiding sword to rotatably support the saw blade.

However Odendahl, et al, does not disclose the internal mechanism for driving and supporting the saw blade in operation of the compass saw apparatus and therefore cannot suggest anything regarding modifications of the mechanism of the saw apparatus of Godfrey, which are necessary to arrive at the invention as claimed in new independent claim 27. For example. Odendahl, et al, is unconcerned regarding the apparatus component within the transmission housings 16, 160, 216 of figs. 1, 2, and 5 respectively.

Although Godfrey does disclose a saw apparatus with the general components recited on page 5 of the final Office Action, one skilled in the art would not arrive at the subject matter of new independent claim 27 with all the limitations regarding the manner in which the components are connected and cooperate by combining the subject matter of Odendahl with that of Godfrey.

According to page 5 of the final Office Action Godfrey teaches bushings 88 and 90 shown in fig. 1 (column 3, lines 19 to 35), which guide the oscillating motion of the saw blade. However these

bushings actually guide the motion of the plunger 78, which is considered equivalent to the applicants' lifting rod, which is connected by the clamping means to the saw blade; they do not directly guide the motion of the saw blade, but only indirectly by guiding the lifting rod.

Furthermore according to the wording of the new claim 27 the two bracing means are arranged at a location on opposite sides of the saw blade when the saw blade is connected to the lifting rod. Specifically the paragraph of the body of claim 27 that describes the guide assembly is quoted here as follows:

“wherein said guide assembly includes two lateral bracing means arranged in front of the clamping sleeve and on opposite sides of said saw blade when said saw blade is connected to said lifting rod”.

These quoted limitations present in new claim 27 are critical to protecting the clamping sleeve that is directly connected to the saw blade from the shear forces acting on the saw blade in operation, which is a primary object of the applicants' invention. The shear forces are explicitly defined in the paragraph between lines 9 and 15 on page 2 of applicants' specification and are essentially lateral forces acting on the saw blade.

However if the bracing means merely brace or laterally support

the equivalent lifting rod of Godfrey, they cannot function like the applicants' bracing means, because they would not protect the clamping means 94 from shear forces acting laterally on the saw blade connected to the clamping means 94 of Godfrey.

Hence the applicants' guide assembly is unobviously different from the guide assembly described on page 5 of the final Office Action and in Godfrey.

Applicants' claim 27 further states that the two lateral bracing means are arranged in front of the clamping sleeve. In contrast, the bushings 88, 90 are arranged behind the clamping element 94 of Godfrey, as shown in fig. 1 of Godfrey.

The Office Action on page 6 alleges that the wording "in front of" can be given no weight during examination because no frame of reference is set forth. Applicants respectively disagree.

The specification provides the basis of the meaning of "in front of" as it does for other terms used in the applicants' patent claims. For example, M.P.E.P. § 2173.05 (a) which states as follows:

"The meaning of every term used in a claim should be apparent from the prior art *or from the specification* and drawings at the time the application is filed." (*italics for emphasis added*)

Note that the meaning of terms may be made apparent by the specification so that it should not be necessary to include a definition of the term in the claims.

In the case of “in front of”, the term “front” is used in the specification in relation to the power saw apparatus so that the meaning of “in front of the clamping means” would be clear. The power saw apparatus shown in the applicants’ drawing has two grip regions 76a, 78a, shown in figure 1. The grip region 78a is called the “front” grip region in line 15 of page 7 of applicants’ specification. This establishes the side of the saw apparatus in which the saw blade is inserted as the front side and the side on the opposite end having the handle grip 76a and power switch as the rear side, which would be the conventional understanding.

Similarly the front end of the lifting rod is clearly established by the paragraph between lines 10 and 15 of page 8 of the applicants’ specification. Lines 13 to 14 state that the coupling means is located at the front end of the lifting rod 64a, as shown in figure 2. This establishes the location of a front end and a rear end of the lifting rod.

Thus the wording “bracing means is located in front of the clamping sleeve or clamping means” in claim 27 or claim 30 is equivalent to stating that it is between the clamping sleeve or clamping means and the tip of the saw blade when the saw blade is connected to the lifting rod. However that means that the limitation is equivalent to stating the bracing means is arranged on both sides of the saw blade when the saw blade is connected to the lifting rod.

**B. The New Claims are not Obvious from the Combination
Of Godfrey and Odendahl**

It is agreed that the subject matter of Godfrey and Odendahl could be combined, but the result would not be the power saw apparatus claimed in e.g. new independent claim 27. The structure of the power saw apparatus resulting from the combination of these references would not perform the most important function of the applicants' structure and achieve the object of the applicants' invention, which is to protect the clamping means from the shear stresses on the saw blade when the saw blade is connected to the lifting rod and driven by the drive mechanism.

The combined subject matter of the references would need further modifications in order to arrive at the subject matter of claim 27. First the housing of Godfrey would need to be extended so that

it encompasses a guide section of the saw blade at the end of the saw blade connected to the linking rod. Next bracing means must be provided on opposite sides of the saw blade in front of the clamping device 94 of Godfrey.

However according to one test for obviousness the desirability of the modifications of the combined subject matter of the prior art references must be evident to one of ordinary skill in the art. One of ordinary skill in the art would consider the simple clamping means of Godfrey, which is nothing more than a simple piece of metal with a screw or screws through it as shown in figs. 7 to 16, which can have a variety of different holes and/or slots into so that the saw blade can be clamped on the lifting rod or plunger in different orientations. One skilled in the art would not expect significant problems for this type of clamping device if it were exposed to shear stresses acting on the saw blade. If the clamping element 94 loosened as a result of shear forces one skilled in the art would simply tighten the screws through it. Thus one skilled in the art would not be motivated to make the modifications described in the above paragraph, which are necessary to arrive at the applicants' power saw apparatus as claimed in e.g. the new claim 27.

According to M.P.E.P. § 2143.01 the mere fact that the

combined subject matter could be modified to arrive at the applicants' invention may **not** be sufficient to establish prima facie obviousness. Furthermore regarding a required suggestion of the desirability of the necessary modifications the Federal Circuit Court of Appeals has said:

"The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.... It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fritch*, 23 U.S.P.Q. 2nd 1780, 1783-84 (Fed. Cir. 1992).

In contrast, the preferred embodiments of the coupling means of the applicants is not a simply brace or piece of metal with a screw like the element 94 of Godfrey. Instead the applicants' preferred embodiments comprise a detent coupling with a complex structure with a crossbeam that fixes the extension of the saw blade and a restoring spring that engages the coupling, which might be damaged or even inadvertently operated by certain lateral forces applied to the saw blade. Thus there is substantial motivation **for the applicants** to provide the structure with the differences between the combined subject matter of Godfrey and Odendahl, which would **not** be apparent to one of ordinary skill in the art without the applicants' specification with the desired preferred embodiments of the clamping means as a guide.

For the aforesaid reasons and because of the new limitations in independent claims 27 and 30, it is respectfully submitted that new claims 27 to 32 should **not** be rejected under 35 U.S.C. § 103 (a) over Godfrey, et al, US 3,155,128, in view of Odendahl, et al, US 5,644,847.

Should the Examiner require or consider it advisable that the specification, claims and/or drawing be further amended or corrected in formal respects to put this case in condition for final allowance, then it is requested that such amendments or corrections be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing the case to allowance the Examiner is invited to telephone the undersigned at 1-631-549-4700.

In view of the foregoing, favorable allowance is respectfully solicited.

Respectfully submitted,



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